REMARKS

Claims 1, 3-5, 8-17, 37-45 and 47-50 remain pending in the application, with claims 1 and 42 being the independent claims. Reconsideration and further examination are respectfully requested.

In the Office Action, claims 1, 3-5, 8-11, 13, 37-45 and 47-50 were rejected under 35 USC § 102(b) over a Master's thesis titled, "Distribution List Maker Program with Inter-User Capabilities between Universities and Colleges in the Tennessee Board of Regents School System" (Anderson); and claims 12 and 14-17 were rejected under § 103(a) over Anderson in view of page 51 of a publication titled "Microsoft Outlook 2000" published by Microsoft Press ("Microsoft Press"). Withdrawal of these rejections is respectfully requested for the following reasons.

The present invention, as recited in independent claims 1 and 42, concerns (among other things) systems, methods and techniques for addressing an email message by querying a database to identify individuals who satisfy an auxiliary criterion which, in turn, has been specified within an address field for the email message. One benefit of such an approach is that a user often will be able to quickly and easily specify groups of one or more intended email recipients by reference to auxiliary information pertaining to such recipients. Moreover, in certain embodiments in which a database containing originally created/maintained source information is accessed, the resulting recipient list often will be more current and, therefore, more accurate than is possible with conventional email-message-addressing techniques.

Thus, independent claims 1 and 42 are directed to the addressing of an email message, in which at least one auxiliary criterion is defined by accepting a signal from a user input device to at least partially define the at least one auxiliary criterion, with the auxiliary criterion using

information other than information in an email address, and with the signal being included within an address field for the email message (e.g., as described in Paragraphs [44]-[46] of the Specification). The auxiliary criterion is used to identify a group of email addresses by querying at least one database to identify individuals who satisfy the auxiliary criterion (e.g., as described in Paragraph [37] of the Specification). The email message is then sent to the email addresses within the identified group.

The foregoing combination of features is not disclosed by the applied art. For example, Anderson does not say anything at all about the feature of using an auxiliary criterion to identify a group of email addresses by querying at least one database to identify individuals who satisfy the auxiliary criterion, where the auxiliary criterion uses information other than information in an email address and the signal is included within an address field for the email message.

In particular, in Anderson's technique an entire database is first downloaded and stored locally. See, e.g., pages 29-30 of Anderson. Then, that local copy of the database is searched in order to construct a desired email distribution list. See, e.g., pages 32-33 of Anderson. Finally, that distribution list is stored as a static list of email addresses which can be accessed when desired by a user to send a particular email message to the email addresses within the list. See, e.g., page 33, first full paragraph, of Anderson.

One problem with Anderson's approach is that once an email distribution list has been constructed and stored in the described manner, the list remains static. That is, neither changes in the composition of the group (e.g., because a new student has joined the class or because a student has dropped out of the class) nor any changes in the email addresses for the members in the group (e.g., because a student has switched email service providers) are reflected in the list, unless the user goes through the process of reconstructing the appropriate distribution list.

However, as noted in Anderson itself, such a process can take up to 30 minutes (which is only somewhat better than creating the list by hand which, Anderson notes, typically takes 30-60 minutes). See page 41 of Anderson. Moreover, there appears to be nothing in Anderson to alert the user that any such change has taken place and, therefore, nothing to motivate the user to repeat that lengthy process. As a result, any distribution list generated by Anderson's technique, in addition to taking a significant amount of time to construct, often will be out of date.

In contrast, for example, according to the present invention, information pertaining to the auxiliary criterion can be entered into an address field for the email message and then the appropriate recipients are searched based on that auxiliary criterion before the email message is sent. As a result, the present invention often can obtain the most up-to-date information. At the same time, the technique of the present invention often is much faster and easier for the user.

The foregoing remarks were made in the previous Amendment/Response. In response, the Office Action asserts:

> Anderson describes the argued limitation by stating "the user can generate a distribution list by selecting colleges, classifications, and majors from a drop down list box" (pages 32-33, especially, "Class Distribution List" and "Departmental Distribution List").

However, the above-cited quotation from Anderson does not say anything at all about any signal included within an address field for an email message, as presently recited. Rather, it is noted that this quotation is taken from a section of Anderson titled, "Departmental Distribution List", which in turn follows a section titled, "Creating the Distribution List". That earlier section states in its entirety:

> *Once the database is created*, the user then can create distribution lists for the e-mail client selected. There are two types of distribution lists that the List Maker program creates: *lists for an individual class* and *lists for a department*. [Emphasis added]

In other words, Anderson plainly states that the database must be created before either a class distribution list or a departmental distribution list can be created. The foregoing quotation from Anderson therefore reinforces the point made above that Anderson's technique requires an entire database to be first downloaded and stored locally before any distribution list can be created.

Anderson's technique relies on a legacy software program that already was in place at East Tennessee State University and gave users access to Student Information System (SIS) data. More specifically, that legacy program "extracts the class roll information from the various databases that SIS uses and e-mails the class rolls to the requester." Page 11 of Anderson. Anderson's contribution, the List Maker program, then provides additional functionality which, "reads the text from the body of this class roll e-mail message and converts it to a Microsoft Access database." *Id.*

Only after this local database has been created can any distribution list be created. Moreover, in Anderson all tasks associated with creating distribution lists are performed solely using Anderson's separate List Maker program, not by including any kind of signal within an address field for the email message, as presently recited. See, e.g., page 30 of Anderson:

> Information from SIS is returned to the user's e-mail inbox via e-mail . . . The List Maker program allows the user to receive SIS information via an e-mail client built into the List Maker program. This was done to allow the user of the List Maker program to request the information, receive the information, convert the e-mail, and create the distribution list all in one program.

Reinforcing this point is the fact that Anderson's List Maker program apparently interfaces with Microsoft Outlook irrespective of whether or not Outlook is actually open; see, e.g., page 33 of Anderson:

> "The List Maker program uses Microsoft Outlook MAPI service for programming access to Microsoft Outlook. With Microsoft Outlook, a user needs to establish a MAPI session to use Microsoft Outlook. On normal startup of Microsoft Outlook the MAPI login is automatic. Because the List Maker program accesses Microsoft Outlook programmatically, it needs to know if Microsoft Outlook is installed to start the MAPI session."

In addition, Anderson clearly indicates that in its system the creation and saving of a distribution list is an entirely separate task from the subsequent use of that list in an e-mail program. See, e.g., page 32 of Anderson with regard to class distribution lists:

> The output from this list-building query is then written to a distribution list, in the required format, with a user-specified name.

and page 33 of Anderson with regard to departmental distribution lists:

> Once the requested information is extracted, the creation of the distribution list is the same as creating a distribution list for a class. The user can name the distribution list *so that he/she can find the distribution list in the e-mail client.* [Emphasis added]

In short, Anderson consistently indicates that its List Maker program is used to create distribution lists off-line using the following multistep process: (1) a local database is created from the contents of a received email message, (2) a user is allowed to generate distribution lists from that local database using List Maker's own user interface (which includes the drop-down lists mentioned in the Office Action), and then (3) the user is allowed to save those distribution lists for later access through Microsoft Outlook.

The only apparent interaction with an email client in Anderson's system is to store the resulting distribution lists in a manner so that the email client will be able to access them later. As noted above, this is a completely different approach than that of the present invention.

The Office Action references Andersen's SQL statement, "SELECT NAME, EMAIL...", and asserts that such SQL statement, "reasonably describes the signal is included within an

address field for the email message". However, within the entire context of Anderson, as set out above, this SQL statement clearly is just a query, made by Anderson's List Maker program against the local database that has been generated. It is noted that the parameters following the SQL "SELECT" command (i.e., NAME, EMAIL and REG in the example cited in the Office Action) merely indicate what data field values are to be returned from the local database. See, e.g., page 31, second paragraph, of Anderson. Therefore, the entire SQL statement can be interpreted as: retrieve the name email address and registration status for all students whose registration status is "Enrolled" in course Csci 1101001. As noted previously, this SQL statement is submitted through Anderson's List Maker program, independently of any email client.

The Office Action also asserts that it is not correct that an entire database is first downloaded and then stored locally, citing as support the fact that Anderson talks about accessing SIS via the Internet. However, Internet access of SIS is entirely consistent with Applicants' description, set forth above, regarding how Anderson's system works.

Even the portions of Anderson cited in the Office Action support this description. For example, page 11 of Anderson talks about emailing the requested information to the user, which received email message Anderson's program converts into a local Microsoft Access database. Similarly, pages 29-30 of Anderson also talk about returning information from SIS "to the user's e-mail inbox via e-mail" and then converting "information obtained from SIS into a database in order to simplify list generation." In short, there is nothing in the cited portions of Anderson that contradicts Applicants' description of Anderson's system. To the contrary, those portions of Anderson fully support Applicants' description.

In view of the foregoing distinctions, Anderson could not have disclosed the combination of features recited in independent claims 1 and 42. Accordingly, claims 1 and 42 are believed to be allowable over the applied art.

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits is respectfully requested.

In order to sufficiently distinguish Applicants' invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicants' invention. However, no attempt has been made to categorize each novel and unobvious difference. Applicants' invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

If there are any fees due in connection with the filing of the currently submitted papers that have not been accounted for in this paper or the accompanying papers, please charge the fees to Deposit Account No. 08-2025. If an extension of time under 37 C.F.R. 1.136 is required for the filing of any of the currently submitted papers and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to the Deposit Account.

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Respectfully submitted,
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